

**REMARKS**

Claims 1, 28 and 41 are amended.

Claim 43 is new.

Entry of the amendments is respectfully requested.

**Claim Objections**

The Examiner objected to claim 28 for including typographical errors. Applicants have amended this claim to read “sending the electronic folder to a remanufacturer” in accordance with the Examiner’s suggestion. Re-consideration of the matter is respectfully requested.

**Rejections under 35 USC 101**

On pages 2 to 4 of the Office Action, the Examiner rejected claims 1, 2, 4, 7, 9 to 20, and 38 to 41 under 35 U.S.C. § 101 as allegedly not reciting patentable subject matter. More specifically, the Office Action held that because the claims allegedly do not meet the Machine-or-Transformation Test, the claims are deemed not to recite patentable subject matter and the burden is passed to Applicants to demonstrate compliance.

Applicants have amended claim 1 and 41 to recite that the method is embodied on a computer network. Applicants have amended claim 1 further to recite that the description information includes information relating to the type of said vehicular part, and that the step of sending said electronic folder including said description information to an assessment center is done automatically based on the information relating to the type of said vehicular part. Support for this amendment may be found at least at paragraph 26 of the application as published.

Applicants respectfully submit that the subject matter recited in claims 1, 2, 4, 7, 9 to 20, and 38 to 41 is patentable at least for the following reasons:

a) **Machine-Or-Transformation Test Is Not The Sole Test For Patentability**

Applicants respectfully submit that application of the Machine-or-Transformation Test is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101 and further,

Applicants' claims are compliant with 35 U.S.C. § 101 because the claims are not directed to abstract ideas, laws of nature or natural phenomena, as will be described below.

Applicants respectfully note that demonstrating a lack of compliance with the Machine-or-Transformation Test is insufficient to make a *prima facie* rejection under 35 U.S.C. § 101. In its memo to Examiners regarding *Bilski*, the USPTO correctly noted that the Supreme Court stated that the Machine-or-Transformation Test is a "useful and important clue" for determining whether claims recite patentable subject matter (see *In re Bilski*, Slip Op. at 8). However, this merely means that claims meeting the Machine-or-Transformation Test are likely to recite patentable subject matter. It is **not dispositive** that claims that allegedly fail the Machine-or-Transformation Test do not recite patentable subject matter. As stated by the Supreme Court, "[a]dopting the machine-or-transformation test as the sole test for what constitutes a 'process' (as opposed to just an important and useful clue) violates ... statutory interpretation principles" (Slip Op. at 6-7). Rather, the only way the USPTO can currently meet its burden for rejecting claims under 35 U.S.C. § 101 is to demonstrate that the claims are directed to an **abstract idea**, a **law of nature** or **natural phenomena**. **These are the only classes of subject matter explicitly forbidden by the Supreme Court as not being patent-eligible.** The Supreme Court overruled the Machine-or-Transformation Test as the sole test for determining patentable subject matter, so the application of the Machine-or-Transformation Test to allegedly pass the burden to Applicants to demonstrate patentable subject matter is insufficient.

b) The Claims Recite Patent-Eligible Subject Matter because they are not Directed to an Excluded Class

In order to expedite the prosecution of the application, Applicants respectfully submit that the claims are patent-eligible because they are not directed to abstract ideas, laws of nature or physical phenomena.

With regard to the abstract ideas, Applicants respectfully submit that the claimed subject matter is physical rather than being a mere mental process. Unlike the claims at issue in *Bilski*, where the risk hedging method could be largely performed mentally by a human being, the claimed invention recites a method for remotely evaluating a vehicular part which may **only** be implemented using a computer network. In particular, an electronic folder which includes description information about the

vehicular part is sent from the parts dealer to the central server. The central server forwards the electronic folder to an assessment center automatically based on the type of the part, as indicated in the electronic file. At the assessment center the file is updated to include new information (a grade). The updated file is then sent back to the central server. The central server then sends the updated electronic folder to the vehicular dealer to determine a disposition of the vehicular part based on the grade included in the updated file. A notification of the disposition is sent to the original equipment manufacturer.

The Examiner argues that the significant steps are not performed by machines but by humans. However, with due respect, this interpretation is contrary to the “Interim Guidance For Determining Subject Matter Eligibility for Process Claims In View Of *Bilski v. Kappos*”, which repetitively mentions that “*the claims should be read as a whole*” (see page 43923, col.3, par.2). Furthermore, the guidance also states that “*the recitation of some structure such as a machine, or the recitation of some transformative component will in most cases limit the claim to such an application*”. As discussed above, the claimed invention cannot be implemented without the computer network which includes a central server and terminals at the dealer and the assessment center. The computer network recited in the claims is not an extrasolution activity nor a field-of-use but an important element without which the claims do no function.

The Examiner argues that the step of data gathering and outputting is not sufficient to pass the test. Applicants first submit that the guidance does not exclude the step outputting. Second, the method is not limited to gathering and outputting. In particular, the electronic folder requires machines for sending, receiving, interpreting, updating and outputting the content thereof. Claims 2 and 7 recite that the content includes audio and video files, and digital images. Inherently, this type of files may only be interpreted by machines.

Accordingly, Applicants respectfully submit that the claims do not recite abstract ideas.

Further, the claims are not directed to laws of nature or physical phenomena. The claimed invention has been implemented by the applicants to provide a particular solution to a particular problem. The invention has been implemented in a tangible way and the steps thereof are observable and verifiable.

It is respectfully submitted that the claims recite patentable subject matter that is not directed to abstract ideas, laws of nature or physical phenomena. Withdrawal of the rejections under 35 U.S.C. § 101 is respectfully requested.

**Rejections Under 35 USC 102 (b)**

Claims 28, 29, 31, 32 and 36 are rejected as being anticipated by Joao (US2002/00116655A1).

Applicants have amended claim 28 to recite analyzing means adapted to analyze a content of said electronic folder and determine an appropriate assessment center based on a type of said vehicular part, and that the output means are adapted to route the electronic folder to the appropriate assessment center selected by the analyzing means. Support for these amendments may be found at least at paragraph 26 of the application as published.

Claim 28, as presently amended, is patentable over Joao at least for the following reasons:

- a) Claim 28 recites that the output means route the electronic folder back and forth between the assessment center and the vehicular dealer. Joao does not route any folder between different entities of a network. As described at paragraph 288 of Joao, the diagnostic report which is sent to the user computer 20 is generated by the central computer itself and not received from a remote computer.
- b) Claim 28 recites analyzing means adapted to analyze a content of said electronic folder and determine an appropriate assessment center based on a type of said vehicular part. Joao does not determine the destination of an electronic folder based on the type of the vehicular part with which the electronic folder is associated.

Therefore, Joao does not describe all the elements of claim 28 as presently amended.

Withdrawal of the rejections under 35 USC 102(b) against claim 28 and all the claims depending thereon is respectfully requested.

**Rejections Under 35 USC 103 (a)**

1) Claims 1, 2, 4-7, 9-20, and 38 are rejected as being obvious over Joao, Hormozi, and the newly cited Bell reference (U.S. 5,497,235).

**Non-Citable Reference**

Applicants respectfully submit that the rejection under 35 USC 103 (a) is deficient because Bell relates to a totally different field and cannot be not cited against the present application.

In particular, Bell describes a method for inspecting **hosiery** while the present claims relate to a method for the remote evaluation of **vehicular parts**. It is not possible that anyone skilled in the art would be motivated to look in the domain of hosiery to build a system for the remote evaluation of vehicular parts. Therefore, Applicants respectfully submit that Bell is not citable against the present application.

Withdrawal of the rejection against claims 1, 2, 4-7, 9-20, and 38 under 35 USC 103(a) is respectfully requested.

**Claim amendment**

Nevertheless, even if Bell is citable against the present application, which is not admitted but denied, the combination of Joao, Harmozi and Bell would still fail to disclose all the elements of claim 1 as presently amended.

In particular, claim 1 recites automatically routing, from a central server, said electronic folder including said description information to an assessment center based on the information relating to the type of said vehicular part.

As discussed above, Joao does not route any folder between different entities of a network. The diagnostic report that the central computer 10 sends to the user's computer 20 is generated by the central computer itself and not received from, nor routed to, different remote terminals on the network.

Moreover, claim 1 recites that the electronic folder includes information relating to a type of the vehicular part and that the electronic folder is sent to an assessment center based on the information relating to the type of said vehicular part. Joao does not choose the destination on the basis of the type of a vehicular part nor on the

basis of the content of the electronic file.

Therefore, the combination of Joao, Hormozi, and Bell fails to describe all the elements of claim 1 as presently amended.

Withdrawal of the rejection against claims 1, 2, 4-7, 9-20, and 38 under 35 USC 103(a) is respectfully requested.

2) Claim 41 has been rejected as being obvious by the combination of Joao and Hormozi.

Claim 41 is amended to recite “analyzing a content of said electronic folder and selecting an assessment center based on a type of the vehicular part”.

As discussed above, Joao does not choose the destination on the basis of the type of a vehicular part nor on the basis of the content of the electronic file.

Therefore, the combination of Joao and Hormozi, fails to describe all the elements of claim 41 as presently amended.

Withdrawal of the rejection against claim 41 under 35 USC 103(a) is respectfully requested.

3) Claims 33, 34 and 37 is rejected as being obvious by Joao. The rejection is believed to be overcome by the amendments effected in claim 28 on which claims 33, 34 and 37 depend.

Withdrawal of all the rejections under 35 USC 103(a) is respectfully requested.

#### **New Claim**

Claim 43 is new. Support for this claim may be found at least in claim 28 and in paragraph 26 of the application as published. Entry and allowance of this claim is respectfully requested.

In view of the above arguments and amendments, it is respectfully submitted that the application is in good condition for allowance. A notice to this effect is earnestly solicited.

Respectfully,

Wilfried Blum et al.

By:

/C. Marc Benoît/

C. Marc Benoît

(Reg. 50,200)

Agent of Record

Benoît & Côté, s.e.n.c.

Tel: (514) 658-4844, #210

Customer No.: 76753